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BAKER & DANIELS LLP 300 NORTH MERIDIAN STREET SUITE 2700 INDIANAPOLIS, IN 46204			ANTHONY, JOSEPH DAVID	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/692,025

Filing Date: October 19, 2000

Appellant(s): NERI ET AL.

Thomas A. Ladd
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02/23/2005.

(1) Real Party in Interest

5.0.51

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-6, 8-14, and 18-21.

Claims 15-17 are withdrawn from consideration as not directed to the elected invention.

Claim 7 has been canceled.

Claims 22-24 have not been examined since they were first filed in the after final amendment filed on 12/21/2004 (OIPE Stamp date) which was not entered and will not be entered.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect. While it is true that the after final amendment filed on 12/21/2004 (OIPE stamp date) had not been subject to an office action at the time applicant filed the Appeal Brief, said after-final amendment has been considered by the

examiner as of the writing of this Examiner's Answer and will not be entered because it does not advanced the persecution of the application (all of the claims under final rejection were not amended by applicant in the after-final amendment) but rather the rejections were traversed by applicant's representative. The after-final amendment did add new claims 22-24 without canceling a correspond number of old claims and as such the after-final amendment was not entered and will not be entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: Claims 1-6, 8-14 and 18-21 were finally rejected by the office action mailed 03/29/2004 not 03/25/2005 as asserted by appellant.

Furthermore to simplify the issues under appeal and to avoid unnecessary redundancies, the examiner is dropping the previously made final rejections of applicants' claims over the following: Roth U.S. Patent Number 5,173,116, EP 0 514 784 A1, Schneider et al. U.S. Patent Number 4,604,100, Satou et al. U.S. Patent Number 5,017,195 and Nebashi et al. U.S. Patent Number 4,999,138.

Art Unit: 1714

(7) *Grouping of Claims*

The rejection of claims 1-6, 8-14, and 18-21 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

5,455,288	Needham	10-1995
5,888,254	Gang et al.	3-1999
4,729,796	Deubel et al.	3-1988
5,437,688	Yamauchi et al.	8-1995

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6, 8-14 and 18-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application

was filed, had possession of the claimed invention. Applicant's amendment to claim 1 inserting the limitation of "said mixtures being devoid of said organic polymers" is deemed to be new matter. Applicant's assertion that the specification on page 3, lines 11-21, enables such a sweeping negative limitation is not accepted by the examiner. The said specification section is silent on the present of a polymer in applicants' invention. This silent is not to be expanded to positively exclude such polymers.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Please note that applicants' elected claims are product claims written in the format of product-by-process. As is well established by the courts, the process in product-by-process is given no patentable weight unless there is some showing of criticality that the process results in a product that is somehow different from a product produced by a different process. Applicant's originally filed specification and claims have set forth absolutely no showing of any distinctiveness, criticality, superior or

unobvious results that may or may not occur to applicants' claimed product when it is made by applicants' process. As such, for the following prior-art rejections, applicants' claims are deemed to be anticipated over the granules produced by the applied prior-art references even if their process of making the granules differs from applicants' process of making the granules. The examiner also wants to make the point that the particulate resin component as set forth in Example 1 of the following applied Needham patent is not excluded by applicants' new matter claim language of: "said mixtures being devoid of **said** organic polymers", [emphasis added]. For more details on this issue regarding the Needham patent, see the examiner's comments in the below "**Response to Argument**" section of the present Examiner's Answer.

Claims 1-6, 8-14, and 18-21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Needham U.S Patent Number 5,455,288 or Gang et al. U.S. Patent Number 5,888,254 or Deubel et al. U.S. Patent Number 4,729,796 or Yamauchi et al. U.S. Patent Number 5,437,688.

Needham teaches dustless color concentrate granules that comprise a dye/pigment and a stabilizer. Applicants' claims are anticipated over Example 1 which teaches the production of dustless color concentrate granules that comprise: 1) a pigment mixture comprising carbon black, titanium dioxide, diazo yellow, and phthalocyanine green) (reads at least on applicant's organic, inorganic and dye component of claim 1); 2) a particulate resin which is HDPE (i.e. high density polyethylene); 3) a binder (reads at least on applicants' rheological additive of claim 5; 4) zinc stearate (reads at least on applicant's

lubricant component of claim 5), 5) a UV stabilizer, which is Cyanamid UV-3346 (reads at least on applicants' stabilizer component of claim 1); and 6) an antioxidant which is a mixture of Irganox 1076 and Irgafos 168 (also reads at least on applicants' stabilizer component of claim 1).

Gang et al teach leuco vat-dye preparations in granular form. Applicant's claims are deemed to be anticipated over the examples, such as example 8 which teaches forming granules which comprise in part: 1) leucoindiago (reads at least on applicants' claimed dye of claim 1); 2) sodium hydroxide (reads on applicants' claimed stabilizer component of claim 1, and also on the rheological additive or catalyst of claim 5); and 3) ascorbic acid (also reads at least on applicant's stabilizer component of claim 1).

Deubel et al teach a process for the preparing pigment granules from aqueous suspension of pigment and alkaline solution of resin. Applicant's claims are anticipated over the examples that comprise a pigment and an antioxidant. Example 1 teaches making a granular product which comprises in part: 1) Pigment Yellow 12 (reads on applicants' pigment component of claim 1); 2) sodium hydroxide (reads on applicants' claimed stabilizer component of claim 1, and also on the rheological additive or catalyst of claim 5); and as an antioxidant pentaerythrityl-tetrakis[3-(3,5-ditert-butyl-4-hydroxy-phenyl)-propionate] (reads at least on applicants' stabilizer component of claim 1).

Yamauchi et al teach granular reactive dye compositions and method of making thereof. Applicant's claims are anticipated over all the examples that

comprise a dye and an antioxidant. Example 1 teaches making granules that comprise in part: 1) a dye of formula (a) (reads at least on applicants' dye of claim 1); 2) sodium primary phosphate (reads at least on applicants' stabilizer component of claim 1); and 3) anhydrous sodium sulfate (reads at least on applicants' claimed rheological agent of claim 5).

(11) Response to Argument

In response to applicants' traversal, on page 3-5 of the Appeal Brief, of the examiner made "new matter" rejection made under 35 USC 112 first paragraph, the examiner makes the following comments.

To begin with, it must be clearly pointed out that applicants' amendment to claim 1 adding the limitation of: "said mixtures being devoid of said organic polymers" does NOT exclude all polymers or polymeric binders from the scope of claim 1. The said claim limitation only excludes from the granules a polymer that is of the same species as that which the granules are to be added to for stabilization and coloring purposes. For example, if the stabilizer granules are to be added to a low density polyethylene resin, the additives that are mixed together to make up the granules themselves can encompass polymeric additives such as a high density polyethylene or polypropylene resin or polyamide or PVC or polyacrylates etc.. This claim interpretation of the examiner's is support by the fact that many of the components claimed in applicant's dependent claims read on polymers, such as the fillers and reinforcing agents (e.g. binders) of claim 2, and the lubricants, emulsifying agent, and the rheological additives

of claim 5. The examiner holds that if applicants had really originally intended to positively exclude polymers from their additive mixture they would have made an explicit statement to such in the specification, and also would not have written the specification and claims as they did to read directly on various additives that can be polymeric in nature, such as fillers and reinforcing agents of claim 2, and the lubricants, emulsifying agent, and rheological additives.

Applicant argues that their specification at page 2, lines 11-18 and at page 3, lines 17-19 supports applicants' position that there is enablement for applicants' amendment to claim 1 inserting the limitation of: "said mixtures being devoid of said organic polymers" since applicants' invention does not require the polymer used in a "masterbatch". Applicants ask a question on page 5 of the Appeal Brief of: "How can it be that the objected to language is recognized and described as a masterbatch in the Final Office Action but not supported by the language of the specification at p.2, lines 14-18 which excludes a "masterbatch"?"

First off, the examiner is required in the course of the examination process to give the broadest reasonable interpretation to the scope of applicant's submitted amendments. The fact that the examiner has recognized that applicants' amendment was trying to exclude the polymer that is found in a masterbatch, does not mean that applicant's originally filed disclosure has an enabling support for such. That is precisely why the examiner made a "new matter" rejection over the said amendment.

Secondly, page 2, lines 11-18 does not provide support for applicants' said amendment because this section of applicants' specification is merely describing a

"masterbatch" formulation of the prior-art, and is thus not describing the metes and bounds of the scope of applicants enabled invention.

Thirdly, applicants' disclosure at page 3, lines 17-19, which does describe applicants' invention, also does not provide enabling support for applicants' sweeping negative limitation of "said mixtures being devoid of said organic polymers" as set forth in claim 1. Page 3, lines 17-19 of applicants' specification, merely discloses that applicants' extrusion process for forming the granules, can be performed but does not have to be performed, at a temperature lower than the temperature at which additives are processed in an extrusion process of masterbatches of the prior-art. Somehow from said disclosure of applicants' specification, applicants argue that there is an enabling disclosure for applicants' amendment to claim 1 inserting the sweeping negative limitation of: "said mixtures being devoid of said organic polymers". The examiner rejects applicants' argument. It must be clearly pointed out that page 3, lines 17-19 of applicants specification as well as applicants' claim 1, do not in any way limit the upper temperature range of applicants' extrusion process that may somehow necessitate and thus provide enablement for applicants' position that the mixtures used to make their granules must be free of the polymers used in masterbatches. In other words, applicants' extrusion process, as discloses on page 3, lines 17-19, directly encompasses the higher temperatures used in the extrusion processes used in the masterbatches of the some prior-art references and thus does not necessitate the positive elimination of the polymers used in the masterbatches of the prior-art.

In response to applicants' traversal of the prior-art rejections, in the Appeal Brief, the examiner makes the following comments. Please note that applicants' elected claims are product claims written in the format of product-by-process. As is well established by the courts, the process in product-by-process is given no patentable weight unless there is some showing of criticality that the process results in a product that is somehow different from a product produced by a different process. Applicant's originally filed specification and claims have set forth absolutely no showing of any distinctiveness, criticality, superior or unobvious results that may or may not occur to applicants' claimed product when it is made by applicants' process. As such, the above prior-art rejections, are deemed to be proper in that they all individually teach the production of granules that comprise every component claimed by applicants even if their process of making the granules themselves differs from applicants' process of making the granules.

The examiner wants to make the point that the particulate resin component as set forth in Example 1 of the applied Needham patent is not excluded by applicants' new matter claim language of: "said mixtures being devoid of **said** organic polymers", [emphasis added] ,because said limitation only excludes from the granules a polymer that is of the same polymeric species as that which the granules are to be added to for stabilization and coloring purposes. This claim interpretation of the examiner's is support by the fact that many of the components claimed in applicant's dependent claims read on polymers, such as the fillers and reinforcing agents (e.g. binders) of claim 2, and the lubricants, emulsifying agent, and the rheological additives of claim 5.

The Needham disclosure directly encompasses the addition of the produced colored dustless granules to another polymer that is to be stabilized and colored that is distinct from the polymer used to make the granules themselves, see column 2, line 66 to column 3, lines 12. Also see Example 2, wherein the produced colored concentrate granules that comprise HDPE (i.e. high density polyethylene) is added at a ratio of 50:1 to polyethylene, which is a distinct polymer with recognized distinct properties from that of HDPE.

Finally, the stabilized and colored granules produced by the applied prior-art references directly meet one of the primary goals of applicants' invention which is to solve the problem of dispersal into the air of polymer additives in powder form, see page 1, line 22 to page 2, line 2 of applicants' specification.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Joseph D. Anthony
Primary Examiner
Art Unit 1714

J.D.A.
May 26, 2005

Conferees

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